

REMARKS/ARGUMENTS

Claims 1 to 4, 6, 8 to 15, and 18 to 22 are pending in this application. Claims 1 to 4, 6, 8 to 15, and 18 to 21 are rejected:

- (1) claims 1, 11, and 12 are rejected under 35 U.S.C. § 102(b);
- (2) claims 2 to 4, 10 to 11, 13, and 15 to 21 are rejected under 35 U.S.C. § 103(a);
- (3) claim 10 is rejected under 35 U.S.C. § 112, first paragraph; and
- (4) claims 1 to 4, 6, 8 to 15, and 18 to 21 are rejected under 35 U.S.C. § 112, second paragraph.

Claim 12 is objected to. Claim 22 is withdrawn from consideration. Applicants are herein amending claims 1, 2, 8 to 10, 13, and 18 to 22, and canceling claims 11, 12, and 22, without prejudice or disclaimer. Upon entry of the amendment, claims 1 to 4, 6, 8 to 10, 13 to 15, and 18 to 21 will be pending in this application.

Amendments to the Claims

Applicants are herein amending claim 1 to include the proviso set forth in claim 2 and to clarify the medicament is prepared by admixing a pharmaceutically acceptable carrier with the active ingredient. Support for this amendment is found, *inter alia*, in original claim 2 and on page 45, lines 7 to 11.

Applicants are herein amending claims 2, 8, 9, and 18 to 21 to cancel non-elected subject matter.

Applicants are herein amending claims 10 and 13 to correct the form of the claim, including claim dependency.

Applicants are herein amending claims 1 and 10 to specify the compounds of the invention are useful in a method of treating respiratory syncytial viral infections. Support for

Docket No.: JANS-0027/JAB-1498
Application No.: 10/030,202
Office Action Dated: October 7, 2003

PATENT

this amendment is found in numerous places throughout the specification, including, for example, original claim 12.

Applicants are herein canceling claims 11, 12, and 22, without prejudice or disclaimer. Applicants reserve the right to pursue the non-elected and/or cancelled subject matter in one or more divisional applications.

Applicants submit that the no new matter is introduced by the amendments to the claims.

Rejection under 35 U.S.C. § 102(b)

Claims 1, 11, and 12 are rejected under 35 U.S.C. § 102(b). Applicants are herein canceling claims 11 and 12 and amending claim 1 to exclude certain benzimidazole compounds, thereby obviating the rejection. Accordingly, applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(b).

Rejection under 35 U.S.C. § 103

Claims 2 to 4, 10 to 11, 13, and 15 to 21 are rejected under 35 U.S.C. § 103(a), as allegedly obvious in view of US-A-5,360,807. Applicants respectfully traverse the rejection because there is no motivation to modify the cited reference to achieve applicants' claimed invention.

Applicants submit that it has not established in the office action that the claimed invention is *prima facie* obvious. To establish a proper *prima facie* rejection, the following elements must be shown:

- (1) the reference(s) is (are) available as prior art against the claimed invention;

- (2) the motivation (explicit or implicit) provided by the reference(s) that would have rendered the claimed invention obvious to one of ordinary skill in the art at the time of the invention;
- (3) a reasonable expectation of success;
- (4) the basis for concluding that the claimed invention would have been obvious to do, not merely obvious to try; and
- (5) the reference(s) teach(es) the claimed invention as a whole.

Applicants submit that elements 2, 3, 4 and 5 have not been established. Hence, a *prima facie* obviousness rejection is improper. *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1983).

In the office action, it is alleged that some of the compounds of the invention are structural homologues of the compounds disclosed in US-A-5,360,807. It is further alleged that a skilled artisan would be motivated to modify the reference to achieve the presently claimed invention because such compounds “would be expected to possess similar utilities.” Applicants disagree that the cited reference and the claimed invention “possess similar utilities.” US-A-5,360,807 discloses the use of its compounds in methods of treating warm-blooded animals suffering from *allergic diseases*, whereas the claimed invention is directed to compounds useful in methods for treating respiratory *syncytial viral infections*. Applicants submit that there is no established connection between the treatment of allergic diseases and the treatment of respiratory syncytial viral infections. It is respectfully submitted that a skilled artisan would have no expectation that the compounds of US-A-5,360,807 would be useful in methods of treating respiratory syncytial viral infections and thus would have no motivation to modify the reference, especially in a manner achieve applicants’ claimed invention.

Accordingly, applicants respectfully request withdrawal of the rejection of claims 2 to 4, 10 to 11, 13, and 15 to 21 under 35 U.S.C. § 103(a) in view of US-A-5,360,807.

Rejection under 35 U.S.C. § 112, first paragraph

Claim 10 is rejected under 35 U.S.C. § 112, first paragraph, as allegedly not enabled for treating all types of viral infections. Applicants are herein amending claim 10 to specify that the compounds of formula (I') are useful for treating *respiratory syncytial* viral infections. The specification teaches how to make and use several embodiments encompassed by the claims as a whole without undue experimentation. Specifically, there are several working examples that demonstrate the cytopathology and cytotoxicity of the compounds of the invention (See page 90, line 5 to page 91, line 27). These working examples are representative of the full scope of the claim 10 (as amended), *i.e.*, a method of treating *respiratory syncytial* viral infections.

Applicants, therefore, respectfully submit that claim 10 is fully enabled and request withdrawal of the rejection of claim 10 under 35 U.S.C. § 112, first paragraph.

Rejection under 35 U.S.C. § 112, second paragraph

Claims 1 to 4, 6, 8 to 15, and 18 to 21 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite:

- (1) Claim 1 is herein being amended to more clearly specify the step of the method thereby obviating the rejection with respect to this claim.
- (1) Claims 11 and 12 are herein being cancelled thereby obviating the rejection with respect to these claims.
- (2) Claim 2 and its dependent claims (3, 4, 6, 8 to 15, and 18 to 21) are rejected because of the use of the term “prodrug.” Applicants are herein amending claims 2, 8, and 9 to delete the term “prodrug.”
- (3) Claims 10, 11, and 13 are rejected because they depend from cancelled claims. Applicants are canceling claim 11 and amending claims 10 and 13 to correct the claim dependency.

Docket No.: JANS-0027/JAB-1498
Application No.: 10/030,202
Office Action Dated: October 7, 2003

PATENT

Applicants submit that claims 1 to 4, 6, 8 to 10, 13 to 15, and 18 to 21, as amended, are definite. Accordingly, applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

Claim Objections

Claim 12 is objected to. Applicants are herein canceling claim 12, without prejudice or disclaimer, thereby obviating the objection.

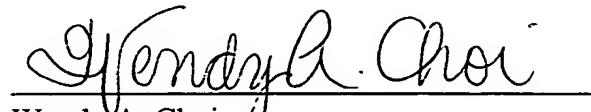
Conclusions

Applicants respectfully request:

- (1) entry of the amendments to the claims;
- (2) reconsideration and withdrawal of the rejection of the claims;
- (3) reconsideration and withdrawal of the objection to claim 10; and
- (4) allowance of claims 1 to 4, 6, 8 to 10, 13 to 15, and 18 to 21.

If the Examiner is of a contrary view, the Examiner is requested to contact the undersigned attorney at (215) 557-3861.

Date: February 5, 2004



Wendy A. Choi
Registration No. 36,697

WOODCOCK WASHBURN LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439